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Stephen P. Moenning

MOEN / 04B

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EXAMINER

VU, QUYNH-NHU HOANG

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



Art Unit: 3763

## DETAILED ACTION

### *Response to Amendment*

Amendment filed on 7/09/08 has been entered.

Claims 12, 14, 17 and 42 are present for examination.

Claims 15-16, 32-41 are withdrawn from the previous Election/Restriction.

Claims 13, 18-31 are cancelled.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 14 and 17, 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon (US 6,228,068).

Yoon discloses a device (Fig. 1-7) comprising: a sleeve 18 having an open distal end, wherein said sleeve has a working channel defined therein through which medical instruments (trocar T) maybe advanced into the body cavity; said sleeve defines a fluid delivery channel 36, 38, 40 (or where is absorb member 20 located, see Figs. 4-5) which is distinct from the working channel, and the fluid delivery channel has an exit 24, 48, 34; a housing 14 secured to the sleeve, the housing 70 having an interior void for receiving said biologically active compound (see Fig. 2, col. 14, lines 1-5); wherein the interior void 62 is in fluid communication with the exit 68 through the fluid delivery channel. It is noted that the interior void/compressible material 62 can include fluid or gel... (col. 12, lines 51-54). In Figs. 2-4, 11, 13-14 or 17 show that the interior void/compressible material 62 is in fluid communication with the exit (holes or at distal 24) through the fluid delivery channel (or thru element 38, 36, 40);

Art Unit: 3763

and a trocar T having a closed converging distal tip positionable between a first trocar position when the trocar T being located within said working channel of said sleeve (Fig. 11); and the trocar is completely removed from said working channel of said sleeve when said trocar is in second trocar position.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 14, 17 and 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent Nos. 6,063,060. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are not structurally distinguishable from the claims in the patents.

### ***Response to Arguments***

Applicant's arguments with respect to claims 12, 14, 17 and 42 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3763

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh-Nhu H. Vu whose telephone number is 571-272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763

Quynh-Nhu H. Vu  
Examiner  
Art Unit 3763